

110TH CONGRESS  
2D SESSION

# H. R. 5889

To provide a limitation on judicial remedies in copyright infringement cases involving orphan works.

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## IN THE HOUSE OF REPRESENTATIVES

APRIL 24, 2008

Mr. BERMAN (for himself, Mr. SMITH of Texas, Mr. CONYERS, and Mr. COBLE) introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To provide a limitation on judicial remedies in copyright infringement cases involving orphan works.

1 *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Orphan Works Act  
5 of 2008”.

6 **SEC. 2. LIMITATION ON REMEDIES IN CASES INVOLVING**  
7 **ORPHAN WORKS.**

8 (a) **LIMITATION ON REMEDIES.**—Chapter 5 of title  
9 17, United States Code, is amended by adding at the end  
10 the following:

1 **“§ 514. Limitation on remedies in cases involving or-**  
2 **phan works**

3 “(a) DEFINITIONS.—In this section, the following  
4 definitions shall apply:

5 “(1) MATERIALS AND STANDARDS.—The term  
6 ‘materials and standards’ includes—

7 “(A) the records of the Copyright Office  
8 that are relevant to identifying and locating  
9 copyright owners;

10 “(B) sources of copyright ownership infor-  
11 mation reasonably available to users, including  
12 private databases;

13 “(C) industry practices and guidelines of  
14 associations and organizations;

15 “(D) technology tools and expert assist-  
16 ance, including resources for which a charge or  
17 subscription fee is imposed, to the extent that  
18 the use of such resources is reasonable for, and  
19 relevant to, the scope of the intended use; and

20 “(E) electronic databases, including data-  
21 bases that are available to the public through  
22 the Internet, that allow for searches of copy-  
23 righted works and for the copyright owners of  
24 works, including through text, sound, and  
25 image recognition tools.

1           “(2) NOTICE OF CLAIM FOR INFRINGEMENT.—

2           The term ‘notice of the claim for infringement’  
3           means, with respect to a claim for copyright in-  
4           fringement, a written notice that includes at a min-  
5           imum the following:

6                   “(A) The name of the owner of the in-  
7                   fringed copyright.

8                   “(B) The title of the infringed work, any  
9                   alternative titles of the infringed work known to  
10                  the owner of the infringed copyright, or if the  
11                  work has no title, a description in detail suffi-  
12                  cient to identify it.

13                  “(C) An address and telephone number at  
14                  which the owner of the infringed copyright may  
15                  be contacted.

16                  “(D) Information from which a reasonable  
17                  person could conclude that the owner of the in-  
18                  fringed copyright’s claims of ownership and in-  
19                  fringement are valid.

20           “(3) OWNER OF THE INFRINGED COPYRIGHT.—

21           The ‘owner of the infringed copyright’ is the legal  
22           owner of the exclusive right under section 106 that  
23           is applicable to the infringement in question, or any  
24           party with the authority to grant or license that  
25           right.

1           “(4) REASONABLE COMPENSATION.—The term  
2           ‘reasonable compensation’ means, with respect to a  
3           claim for infringement, the amount on which a will-  
4           ing buyer and willing seller in the positions of the  
5           infringer and the owner of the infringed copyright  
6           would have agreed with respect to the infringing use  
7           of the work immediately before the infringement  
8           began.

9           “(b) CONDITIONS FOR ELIGIBILITY.—

10           “(1) CONDITIONS.—

11           “(A) IN GENERAL.—Notwithstanding sec-  
12           tions 502 through 505, and subject to subpara-  
13           graph (B), in a civil action brought under this  
14           title for infringement of copyright in a work,  
15           the remedies for infringement shall be limited  
16           in accordance with subsection (c) if the in-  
17           fringer—

18           “(i) proves by a preponderance of the  
19           evidence that before the infringement  
20           began, the infringer, a person acting on be-  
21           half of the infringer, or any person jointly  
22           and severally liable with the infringer for  
23           the infringement—

24           “(I) performed and documented  
25           a qualifying search, in good faith, for

1 the owner of the infringed copyright;  
2 and

3 “(II) was unable to locate the  
4 owner of the infringed copyright;

5 “(ii) before using the work, filed with  
6 the Register of Copyrights a Notice of Use  
7 under paragraph (3);

8 “(iii) provided attribution, in a man-  
9 ner that is reasonable under the cir-  
10 cumstances, to the owner of the infringed  
11 copyright, if such owner was known with a  
12 reasonable degree of certainty, based on in-  
13 formation obtained in performing the  
14 qualifying search;

15 “(iv) included with the use of the in-  
16 fringing work a symbol or other notice of  
17 the use of the infringing work, in a man-  
18 ner prescribed by the Register of Copy-  
19 rights;

20 “(v) asserts in the initial pleading to  
21 the civil action the right to claim such limi-  
22 tations;

23 “(vi) consents to the jurisdiction of  
24 United States district court, or such court

1 holds that the infringer is within the juris-  
2 diction of the court; and

3 “(vii) at the time of making the initial  
4 discovery disclosures required under Rule  
5 26 of the Federal Rules of Civil Procedure,  
6 states with particularity the basis for the  
7 right to claim the limitations, including a  
8 detailed description and documentation of  
9 the search undertaken in accordance with  
10 paragraph (2)(A).

11 “(B) EXCEPTION.—Subparagraph (A)  
12 does not apply if, after receiving notice of the  
13 claim for infringement and having an oppor-  
14 tunity to conduct an expeditious good faith in-  
15 vestigation of the claim, the infringer—

16 “(i) fails to negotiate reasonable com-  
17 pensation in good faith with the owner of  
18 the infringed copyright; or

19 “(ii) fails to render payment of rea-  
20 sonable compensation in a reasonably time-  
21 ly manner.

22 “(2) REQUIREMENTS FOR SEARCHES.—

23 “(A) REQUIREMENTS FOR QUALIFYING  
24 SEARCHES.—

1           “(i) IN GENERAL.—For purposes of  
2 paragraph (1)(A)(i)(I), a search is quali-  
3 fying if the infringer undertakes a diligent  
4 effort to locate the owner of the infringed  
5 copyright.

6           “(ii) DETERMINATION OF DILIGENT  
7 EFFORT.—In determining whether a  
8 search is diligent under this subparagraph,  
9 a court shall consider whether—

10           “(I) the actions taken in per-  
11 forming that search are reasonable  
12 and appropriate under the facts rel-  
13 evant to that search, including wheth-  
14 er the infringer took actions based on  
15 facts uncovered by the search itself;

16           “(II) the infringer employed the  
17 applicable best practices maintained  
18 by the Register of Copyrights under  
19 subparagraph (B); and

20           “(III) the infringer performed  
21 the search before using the work and  
22 at a time that was reasonably proximi-  
23 mate to the commencement of the in-  
24 fringement.

1           “(iii) LACK OF IDENTIFYING INFOR-  
2           MATION.—The fact that a particular copy  
3           or phonorecord lacks identifying informa-  
4           tion pertaining to the owner of the in-  
5           fringed copyright is not sufficient to meet  
6           the conditions under paragraph  
7           (1)(A)(i)(I).

8           “(B) INFORMATION TO GUIDE SEARCHES;  
9           BEST PRACTICES.—

10           “(i) STATEMENTS OF BEST PRAC-  
11           TICES.—The Register of Copyrights shall  
12           maintain and make available to the public,  
13           including through the Internet, current  
14           statements of best practices for conducting  
15           and documenting a search under this sub-  
16           section.

17           “(ii) CONSIDERATION OF RELEVANT  
18           MATERIALS AND STANDARDS.—In main-  
19           taining the statements of best practices re-  
20           quired under clause (i), the Register of  
21           Copyrights shall, from time to time, con-  
22           sider materials and standards that may be  
23           relevant to the requirements for a quali-  
24           fying search under subparagraph (A).

1           “(3) NOTICE OF USE ARCHIVE.—The Register  
2 of Copyrights shall create and maintain an archive  
3 to retain the Notice of Use filings under paragraph  
4 (1)(A)(i)(III). Such filings shall include—

5                   “(A) the type of work being used, as listed  
6 in section 102(a) of this title;

7                   “(B) a description of the work;

8                   “(C) a summary of the search conducted  
9 under paragraph (1)(A)(i)(I);

10                  “(D) the owner, author, recognized title,  
11 and other available identifying element of the  
12 work, to the extent the infringer knows such in-  
13 formation with a reasonable degree of certainty;

14                  “(E) a certification that the infringer per-  
15 formed a qualifying search in good faith under  
16 this subsection to locate the owner of the in-  
17 fringed copyright; and

18                  “(F) the name of the infringer and how  
19 the work will be used.

20 Notices of Use filings retained under the control of  
21 the Copyright Office shall be furnished only under  
22 the conditions specified by regulations of the Copy-  
23 right Office.

24           “(4) PENALTY FOR FAILURE TO COMPLY.—If  
25 an infringer fails to comply with any requirement

1 under this subsection, the infringer is subject to all  
2 the remedies provided in section 502 through 505,  
3 subject to section 412.

4 “(c) LIMITATIONS ON REMEDIES.—The limitations  
5 on remedies in a civil action for infringement of a copy-  
6 right to which this section applies are the following:

7 “(1) MONETARY RELIEF.—

8 “(A) GENERAL RULE.—Subject to sub-  
9 paragraph (B), an award for monetary relief  
10 (including actual damages, statutory damages,  
11 costs, and attorney’s fees) may not be made  
12 other than an order requiring the infringer to  
13 pay reasonable compensation to the legal or  
14 beneficial owner of the exclusive right under the  
15 infringed copyright for the use of the infringed  
16 work.

17 “(B) FURTHER LIMITATIONS.—An order  
18 requiring the infringer to pay reasonable com-  
19 pensation for the use of the infringed work may  
20 not be made under subparagraph (A) if the in-  
21 fringer is a nonprofit educational institution, li-  
22 brary, or archives, or a public broadcasting en-  
23 tity (as defined in subsection (f) of section 118)  
24 and the infringer proves by a preponderance of  
25 the evidence that—

1           “(i) the infringement was performed  
2           without any purpose of direct or indirect  
3           commercial advantage,

4           “(ii) the infringement was primarily  
5           educational, religious, or charitable in na-  
6           ture, and

7           “(iii) after receiving notice of the  
8           claim for infringement, and after con-  
9           ducting an expeditious good faith inves-  
10          tigation of the claim, the infringer prompt-  
11          ly ceased the infringement,

12          except that if the legal or beneficial owner of  
13          the exclusive right under the infringed copy-  
14          right proves, and the court finds, that the in-  
15          fringer has earned proceeds directly attributable  
16          to the infringement, the portion of such pro-  
17          ceeds so attributable may be awarded to such  
18          owner.

19          “(C) EFFECT OF REGISTRATION ON REA-  
20          SONABLE COMPENSATION.—If a work is reg-  
21          istered, the court may, in determining reason-  
22          able compensation under this paragraph, take  
23          into account the value, if any, added to the  
24          work by reason of such registration.

25          “(2) INJUNCTIVE RELIEF.—

1           “(A) GENERAL RULE.—Subject to sub-  
2 paragraph (B), the court may impose injunctive  
3 relief to prevent or restrain any infringement  
4 alleged in the civil action.

5           “(B) EXCEPTION.—In a case in which the  
6 infringer has prepared or commenced prepara-  
7 tion of a work that recasts, transforms, adapts,  
8 or integrates the infringed work with a signifi-  
9 cant amount of the infringer’s original expres-  
10 sion, any injunctive relief ordered by the  
11 court—

12                   “(i) may not restrain the infringer’s  
13 continued preparation or use of that new  
14 work;

15                   “(ii) shall require that the infringer  
16 pay reasonable compensation to the legal  
17 or beneficial owner of the exclusive right  
18 under the infringed copyright for the use  
19 of the infringed work; and

20                   “(iii) shall require that the infringer  
21 provide attribution, in a manner that is  
22 reasonable under the circumstances, to the  
23 owner of the infringed copyright, if re-  
24 quested by such owner.

1           “(C) LIMITATIONS.—The limitations on in-  
2           junctive relief under subparagraphs (A) and (B)  
3           shall not be available to an infringer if the in-  
4           fringer asserts in the civil action that neither  
5           the infringer or any representative of the in-  
6           fringer acting in an official capacity is subject  
7           to suit in the courts of the United States for an  
8           award of damages to the legal or beneficial  
9           owner of the exclusive right under the infringed  
10          copyright under section 106, unless the court  
11          finds that the infringer—

12                   “(i) has complied with the require-  
13                   ments of subsection (b); and

14                   “(ii) has made an enforceable promise  
15                   to pay reasonable compensation to the  
16                   legal or beneficial owner of the exclusive  
17                   right under the infringed copyright.

18          “(D) RULE OF CONSTRUCTION.—Nothing  
19          in subparagraph (C) shall be construed to au-  
20          thorize or require, and no action taken under  
21          such subparagraph shall be deemed to con-  
22          stitute, either an award of damages by the  
23          court against the infringer or an authorization  
24          to sue a State.

1           “(E) RIGHTS AND PRIVILEGES NOT  
2 WAIVED.—No action taken by an infringer  
3 under subparagraph (C) shall be deemed to  
4 waive any right or privilege that, as a matter of  
5 law, protects the infringer from being subject to  
6 suit in the courts of the United States for an  
7 award of damages to the legal or beneficial  
8 owner of the exclusive right under the infringed  
9 copyright under section 106.

10       “(d) EXCLUSION FOR FIXATIONS IN OR ON USEFUL  
11 ARTICLES.—The limitations on monetary and injunctive  
12 relief under this section shall not be available to an in-  
13 fringer for infringements resulting from fixation of a work  
14 in or on a useful article that is offered for sale or other  
15 distribution to the public.

16       “(e) PRESERVATION OF OTHER RIGHTS, LIMITA-  
17 TIONS, AND DEFENSES.—This section does not affect any  
18 right, limitation, or defense to copyright infringement, in-  
19 cluding fair use, under this title. If another provision of  
20 this title provides for a statutory license that would permit  
21 the infringement contemplated by the infringer if the  
22 owner of the infringed copyright cannot be located, that  
23 provision applies instead of this section.

24       “(f) COPYRIGHT FOR DERIVATIVE WORKS AND COM-  
25 PILATIONS.—Notwithstanding section 103(a), an infringer

1 who qualifies for the limitation on remedies afforded by  
 2 this section with respect to the use of a copyrighted work  
 3 shall not be denied copyright protection in a compilation  
 4 or derivative work on the basis that such compilation or  
 5 derivative work employs preexisting material that has been  
 6 used unlawfully under this section.”.

7 (b) TECHNICAL AND CONFORMING AMENDMENT.—  
 8 The table of sections for chapter 5 of title 17, United  
 9 States Code, is amended by adding at the end the fol-  
 10 lowing:

“514. Limitation on remedies in cases involving orphan works.”.

11 **SEC. 3. DATABASE OF PICTORIAL, GRAPHIC, AND SCULP-**  
 12 **TURAL WORKS.**

13 (a) ESTABLISHMENT OF DATABASE.—

14 (1) IN GENERAL.—The Register of Copyrights  
 15 shall undertake a certification process for the estab-  
 16 lishment of an electronic database to facilitate the  
 17 search for pictorial, graphic, and sculptural works  
 18 that are subject to copyright protection under title  
 19 17, United States Code.

20 (2) PROCESS AND STANDARDS FOR CERTIFI-  
 21 CATION.—The process and standards for certifi-  
 22 cation of the electronic database required under  
 23 paragraph (1) shall be established by the Register of  
 24 Copyrights, except that certification may not be  
 25 granted if the electronic database does not contain—

1 (A) the name of all authors of the work,  
2 and contact information for any author if the  
3 information is readily available;

4 (B) the name of the copyright owner if dif-  
5 ferent from the author, and contact information  
6 of the copyright owner;

7 (C) the title of the copyrighted work, if  
8 such work has a title;

9 (D) with respect to a copyrighted work  
10 that includes a visual image, a visual image of  
11 the work, or, if such a visual image is not avail-  
12 able, a description sufficient to identify the  
13 work;

14 (E) one or more mechanisms that allow for  
15 the search and identification of a work by both  
16 text and image; and

17 (F) security measures that reasonably pro-  
18 tect against unauthorized access to, or copying  
19 of, the information and content of the electronic  
20 database.

21 (b) PUBLIC AVAILABILITY.—The Register of Copy-  
22 rights—

23 (1) shall make available to the public through  
24 the Internet a list of all electronic databases that are  
25 certified in accordance with this section; and

1           (2) may include any database so certified in a  
2           statement of best practices established under section  
3           514(b)(5)(B) of title 17, United States Code.

4 **SEC. 4. EFFECTIVE DATE.**

5           (a) **IN GENERAL.**—With respect to works other than  
6           pictorial, graphic, and sculptural works, the amendments  
7           made by section 2 shall apply to infringements that com-  
8           mence on or after January 1, 2009.

9           (b) **PICTORIAL, GRAPHIC, AND SCULPTURAL**  
10          **WORKS.**—With respect to pictorial, graphic, and sculp-  
11          tural works, the amendments made by section 2 shall—

12                 (1) take effect on the earlier of—

13                         (A) the date on which the Copyright Office  
14                         certifies under section 3 at least 2 separate and  
15                         independent searchable, comprehensive, elec-  
16                         tronic databases, that allow for searches of  
17                         copyrighted works that are pictorial, graphic,  
18                         and sculptural works, and are available to the  
19                         public through the Internet; or

20                         (B) January 1, 2013; and

21                 (2) apply to infringing uses that commence on  
22                 or after that effective date.

23           (c) **PUBLICATION IN FEDERAL REGISTER.**—The  
24          Register of Copyrights shall publish the effective date de-  
25          scribed in subsection (b)(1) in the Federal Register, to-

1 gether with a notice that the amendments made by section  
2 2 take effect on that date with respect to pictorial, graph-  
3 ic, and sculptural works.

4 (d) DEFINITION.—In this section, the term “pic-  
5 torial, graphic, and sculptural works” has the meaning  
6 given that term in section 101 of title 17, United States  
7 Code.

8 **SEC. 5. REPORT TO CONGRESS.**

9 Not later than December 12, 2014, the Register of  
10 Copyrights shall report to the Committee on the Judiciary  
11 of the Senate and the Committee on the Judiciary of the  
12 House of Representatives on the implementation and ef-  
13 fects of the amendments made by section 2, including any  
14 recommendations for legislative changes that the Register  
15 considers appropriate.

16 **SEC. 6. STUDY ON REMEDIES FOR SMALL COPYRIGHT**  
17 **CLAIMS.**

18 (a) IN GENERAL.—The Register of Copyrights shall  
19 conduct a study with respect to remedies for copyright in-  
20 fringement claims by an individual copyright owner or a  
21 related group of copyright owners seeking small amounts  
22 of monetary relief, including consideration of alternative  
23 means of resolving disputes currently heard in the United  
24 States district courts. The study shall cover the infringe-  
25 ment claims to which section 514 of title 17, United States

1 Code, apply, and other infringement claims under such  
2 title 17.

3 (b) PROCEDURES.—The Register of Copyrights shall  
4 publish notice of the study required under subsection (a),  
5 providing a period during which interested persons may  
6 submit comments on the study, and an opportunity for  
7 interested persons to participate in public roundtables on  
8 the study. The Register shall hold any such public  
9 roundtables at such times as the Register considers appro-  
10 priate.

11 (c) REPORT TO CONGRESS.—Not later than 2 years  
12 after the date of the enactment of this Act, the Register  
13 of Copyrights shall prepare and submit to the Committee  
14 on the Judiciary of the Senate and the Committee on the  
15 Judiciary of the House of Representatives a report on the  
16 study conducted under this section, including such admin-  
17 istrative, regulatory, or legislative recommendations that  
18 the Register considers appropriate.

19 **SEC. 7. STUDY ON COPYRIGHT DEPOSITS.**

20 (a) IN GENERAL.—The Comptroller General of the  
21 United States shall conduct a study examining the func-  
22 tion of the deposit requirement in the copyright registra-  
23 tion system under section 408 of title 17, United States  
24 Code, including—

1           (1) the historical purpose of the deposit require-  
2           ment;

3           (2) the degree to which deposits are made avail-  
4           able to the public currently;

5           (3) the feasibility of making deposits, particu-  
6           larly visual arts deposits, electronically searchable by  
7           the public for the purpose of locating copyright own-  
8           ers; and

9           (4) the impact any change in the deposit re-  
10          quirement would have on the collection of the Li-  
11          brary of Congress.

12         (b) REPORT.—Not later than 2 years after the date  
13         of the enactment of this Act, the Comptroller General shall  
14         submit to the Committee on the Judiciary of the House  
15         of Representatives and the Committee on the Judiciary  
16         of the Senate a report on the study conducted under this  
17         section, including such administrative, regulatory, or legis-  
18         lative recommendations that the Register considers appro-  
19         priate.

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